

REMARKS

The present amendment is in response to the Office Action dated December 22, 2004. Claims 1-39 are now present in this case. Claims 1, 7, 9, 11, 28, 30, and 32 are amended. Claim 8 is canceled.

The examiner is kindly thanked for his indication that claims 4 and 7 would be allowable if placed in independent form. Claim 7 has been amended to include the subject matter of claim 1 as originally filed with the application. Accordingly, claim 7 is now in condition for allowance.

In a previous response, applicants amended Figure 8A. The present Office Action does not acknowledge the amendment to Figure 8A. Applicants respectfully request entry of the previous amendment to Figure 8A.

Claims 1-3, 5-12, and 28-33 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent Number 6,270,410 to DeMar, et al. In the Office Action, the Examiner indicated that previously added limitations do not sufficiently distinguish the claims over DeMar. The claims have been amended to clearly distinguish the invention over the cited references. Claim 1 is directed to a game piece having a self-contained record-keeping device that adjustably displays variable information and recites *inter alia* "the information being arranged in a plurality of user-selectable groupings." Claim 1 further recites "an indicator manually positionable by a user to indicate a selected one of the plurality of groupings."

DeMar is directed to a slot machine. The three (or more) independent rotating reels on the slot machine are not arranged in a plurality of user-selectable groupings. The three spinning reels operate independently of one another and thus do not form a group. Furthermore, the spinning reels are not user-selectable, as recited in claim 1. Finally, DeMar does not teach or suggest an indicator that can be manually positioned by a user to select one of the plurality of groupings. Accordingly, claim 1 is clearly allowable over DeMar. Claims 2-6, 9, and 10 are also allowable in view of the fact that they depend from claim 1, and further in view of the recitation in each of those claims.

Claim 11 is directed to a game piece in which information is arranged “in a plurality of user-selectable groupings of game play indicia.” Claim 1 also recites “an indicator manually positionable by a user to select one of the plurality of user-selectable groupings.” Finally, claim 11 recites “a receiver portion to receive and removably retain a user-insertable and user-removable indicia altering token therein.”

DeMar does not teach or suggest information arranged in a plurality of user-selectable groupings and does not teach or suggest a manually positionable indicator that allows the user to select one of the plurality of user-selectable groupings. Furthermore, DeMar does not teach or suggest a receiver portion that receives and retains a user-insertable and user-removable indicia altering token, as recited by claim 11. Therefore, claim 11 and dependent claim 12 are allowable over the cited references.

Claim 28 is directed to a game piece with a self-contained record-keeping device that displays variable information and recites *inter alia* “the information being arranged in a plurality of groupings of game play indicia.” Claim 28 further recites “a user-positionable aperture to selectively expose a selected grouping of game play indicia.” Finally, claim 28 recites “a receiver portion to receive and removably retain an indicia altering token therein.”

DeMar is cited as disclosing information arranged in a plurality of groupings. However, the slot machine of DeMar does not disclose a user positionable aperture that allows the user to selectively expose a selected grouping of game play indicia. As one skilled in the art will appreciate, the slot machine produces random combinations of the rotating reels that are not under control of the user. DeMar does not teach or suggest any structure that is comparable to a user-positionable aperture that selectively exposes a selected grouping of game play indicia, as recited in claim 28. Therefore, claim 28 and dependent claim 29 are clearly allowable over DeMar.

Claim 30 is directed to a game piece having “a hand held self-contained record-keeping device that displays variable information relating to the performance characteristics of the game piece.” Claim 30 further recites “an indicator manually

operable by a user to manually vary the displayed information.” Finally, claim 30 recites “a receiver portion to receive and removably retain a user-insertable and user-removable indicia altering token therein.” The slot machine of DeMar is a casino device and does not teach or suggest a hand held self-contained record-keeping device. Furthermore, DeMar does not have an indicator that is manually operable by the user to manually vary the displayed information. In rejecting other claims, the Office Action asserts that DeMar teaches the use of a coin slot to accept money and thereby manually change the value in a coin counter display screen. However, the receiver portion designed to receive coins in DeMar does not permit user insertion and user removal of coins. Thus, DeMar does not disclose a hand held record keeping device with a user-operated manually movable indicator to vary display information and a receiver portion to receive and removably retain a user-insertable and user-removable indicia altering token, as recited in claim 30. Accordingly, claim 30 and dependent claim 31 are allowable over DeMar.

Claim 32 is directed to a game piece having *inter alia* “a self-contained record-keeping device that displays a user-selectable group of information relating to the performance characteristics of the game piece in the game.” Claim 32 further recites “an indicator manually operable by a user to select a user-selectable group of information.” Finally, claim 32 recites a receiver portion to receive and removably retain a user-insertable performance characteristic altering token therein, the receiver portion configured to permit both user insertion and user removal of the token.”

As discussed above, DeMar is directed to a slot machine. DeMar does not teach or suggest a self contained record keeping device that displays a “user-selectable group of information” nor an indicator that is manually operable by the user to select a user-selectable group of information. Accordingly, claim 32 and dependent claim 33 are clearly allowable over DeMar.

Claims 21-37 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent Number 6,182,967 to Green. The applicants respectfully traverse this rejection and request reconsideration. Green discloses a game board in which the game piece may be fitted with prongs (22) to indicate permissible directions of

movement of the game piece. (See column 2, lines 45-61.) The interaction between opposing game pieces is performed by one player's piece "jumping" the game piece of the opponent by " 'jumping' the game piece in a manner similar to that in checkers." (See column 3, line 63-Column 4, line 4.) The game pieces in Green do not teach or suggest a "self-contained record-keeping device having a plurality of discreet groupings of game play indicia" that are "expressed as game play values," as recited in claim 21. Even if *arguendo* the prongs were considered to be game play indicia, Green does not teach a method in which game play values are "selected to produce outcomes of the simulated interactions between the first and second game pieces according to the set of rules by an comparison of a number determined based upon the game play values of the game play indicia in one grouping of the first game piece with a number determined based upon the game play values of the game play indicia in one grouping of the second game piece," as recited in claim 21 (emphasis added). Green does not teach or suggest any game play values nor numbers that are based on game play values nor a comparison of a number in the first game piece based on the game play values of the first game piece with a number based upon game play values of the second game piece. For these reasons alone, claim 21 is clearly allowable over Green.

Claim 22 is directed to a method of playing a game with first and second movable game pieces on a playing surface with "each of the first and second games pieces including a self-contained record-keeping device having a plurality of alterable game values indicative of the operational characteristics of the first and second game pieces, respectively, and a receiver for portion in the first game piece to receive and removably retain a token to thereby alter a selected game value." Even if *arguendo*, the prongs in Green are interpreted as alterable game play values, Green does not teach or suggest "comparing the altered game play value of the first game piece with the game play value of the second game piece, and based on the comparison determining an outcome of the initial simulated interaction between the first and second game pieces according to the set of game rules, " as recited in claim 22. As noted above, the outcome of interaction between game pieces in Green is determined by one piece simply "jumping" the opponent's game piece in a manner similar to checkers. (See

column 3, lines 62-65.) There is no comparison of game play values between the game pieces. Accordingly, claim 22 is clearly allowable over Green. Claims 23-27 are also allowable in view of the fact that they depend from claim 22, and further in view of the recitation in each of those claims.

Claim 28 recites *inter alia* “a user-positionable aperture to selectively expose a selected grouping of game play indicia.” Green does not teach or suggest any such aperture or even groupings of game play indicia. Therefore, claim 28, and dependent claim 29 are clearly allowable over Green.

Claim 30 is directed to a game piece that recites *inter alia* “a hand held self-contained record-keeping device that displays variable information relating to the performance characteristic of the game piece in the game, the information being arranged as an indicia having a plurality of numeric game play values.” Claim 30 also recites “an indicator manually operable by a user to manually vary the displayed information.” As discussed above, Green does not teach, or even suggest numeric game play values as part of the variable information. Furthermore, Green does not teach or suggest a manually operable indicator to manually vary the displayed information. For these reasons, claim 30 and dependent claim 31 are clearly allowable over Green.

Claim 32 is directed to a game piece and recites *inter alia* “a self-contained record-keeping device that displays a user-selectable group of information.” Claim 32 further recites “an indicator manually operable by a user to select a user-selectable group of information” as well as “a receiver portion to receive and removably retain a user-insertable performance characteristic altering token therein.” Green does not teach or suggest any corresponding structures. The Office Action describes the prongs in Green as value altering tokens. However, the tokens merely indicate possible directional movements for the game piece and are never organized in a group. Green does not teach or suggest any device that displays a user-selectable group of information as recited in claim 32. Furthermore, Green does not teach or suggest an indicator manually operable by a user to select a user-selectable group of information. Even if *arguendo*, the prongs of Green are analogous to the performance characteristic

altering tokens of claim 32, there is no structure in Green equivalent to the indicator recited in claim 32. Accordingly, claim 32 and dependent claim 33 are clearly allowable over Green.

Claim 34 is directed to a method for playing the game according to game rules with first and second movable game pieces. Claim 34 recites *inter alia* “associating a performance characteristic altering indicator with the first game piece to alter a performance characteristic of the first game piece.” When the first and second game pieces are moved into a position to initiate a simulated interaction, claim 34 recites “comparing the altered performance characteristic of the first game piece with a corresponding performance characteristic of the second game piece and, based on the comparison, determining an outcome of the simulated interaction between the first and second game pieces according to the set of game rules.” Green describes no equivalent process. As discussed above, the outcome of interaction between first and second game pieces in Green is determined solely by the first game piece jumping over the second game piece, in a manner similar to checkers. Although the prongs on Green indicate permitted directions of movement, the outcome of the interaction is not based on the prongs. Furthermore, there is no comparison of performance characteristics between the first and second game pieces. In Green, if the first game piece is jumping over the second game piece, the presence of prongs on the second game piece is irrelevant to the outcome. Therefore, there is no teaching or suggestion in Green of the comparison step recited in claim 34. Accordingly, claim 34 and dependent claims 35-39 are clearly allowable over Green.

Claims 34-39 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Number 4,083,564 to Matsumoto. The applicants respectfully traverse this rejection and request reconsideration. Relevant portions of claim 34 have been quoted above with respect to the rejection over Green. However, these points are equally relevant to Matsumoto. The Office Action refers to element 32 in Matsumoto as a record keeping device and element 52 as a performance altering indicator. However, element 32 is merely a cover and provides not record keeping value. The rotating disk (52) provides a variable indication of the number of spaces that a player may move.

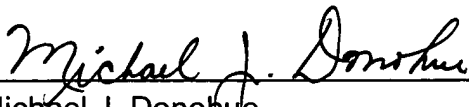
However, Matsumoto does not teach or suggest a step of comparing an altered performance characteristic of the first game piece with the corresponding performance characteristic of the second game piece in determining an outcome based on the comparison as required by claim 34. The outcome of interaction in Matsumoto is determined when the first game piece lands on the space occupied by the second game piece. There is no comparison of the numeric values shown on the disks. If the first game piece lands on the space occupied by the second game piece, the second game piece is captured. (See column 3, lines 60-63.) Nothing in Matsumoto teaches or suggests the comparison of performance characteristics between the first and second game pieces to determine an outcome. Accordingly, claim 34 and dependent claims 35-39 are clearly allowable over Masumoto.

Claims 13-16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable in view of the combination of DeMar and U.S. Patent Number 5,242,163 to Fulton. The applicants respectfully traverse this rejection and request reconsideration. The Office Action states that DeMar teaches all limitations except for multiple members interacting with each other and describes Fulton as teaching interaction between game machines. However, neither of the references, either taken alone or in combination, suggest game pieces wherein a first member has “a plurality of discrete grouping of game play indicia ... indicating information related to a different aspect of play of the game and being expressed as game play values,” as recited in claim 13. The recitation of a first member having groupings of indicia expressed as game play values is a structural limitation. Claim 13 further recites that “the game play values of a plurality of the game play indicia in at least one of the groupings of the first game piece having different values than the game play values of a plurality of the game play indicia of the same type in at least one of the groupings of the second game piece.” Neither DeMar nor Fulton disclose such an apparatus. Indeed, the multiple player games of Fulton would not operate in a fair manner if the game play indicia of one game piece were different from the game play indicia of the second game piece. Finally, claim 13 recites “a second member having an indicator portion positioned to indicate one of the groupings” with “one of the first and second members being

selectively manually movable relative to the other of the first and second members to selectively positioned indicator portion to indicate the one of the groupings.” The Office Action does not indicate what elements within the cited references correspond to first and second members wherein the first member has a plurality of discrete groupings of game play indicia and a second member having an indicator portion to indicate one of the groupings wherein one of the first and second members are selectively manually movable relative to the other of the first and second members to selectively position the indicator portion to indicate the one of the groupings, as recited in claim 13. Accordingly, claim 13, and dependent claims 14-16 and 18-20 are clearly allowable over the cited references.

In view of the above amendments and remarks, reconsideration of the subject application and its allowance are kindly requested. The applicants have made a good faith effort to place all claims in condition for allowance. If questions remain regarding the present application, the Examiner is invited to contact the undersigned at (206) 628-7640.

Respectfully submitted,
Jordan K. Weisman et al.
Davis Wright Tremaine LLP



Michael J. Donohue
Registration No. 35,859

MJD:gatc

2600 Century Square
1501 Fourth Avenue
Seattle, Washington 98101-1688
Phone: (206) 622-3150
Fax: (206) 6628-7699

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